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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,733	01/11/2000	PATRICK V. WARREN	DIVER1240-5	6043

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EXAMINER

SLOBODYANSKY, ELIZABETH

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 03/22/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/481,733	WARREN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Elizabeth Slobodyansky	1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 January 2002.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-14 and 17-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3, 13, 14, 17-35 is/are rejected.
- 7) Claim(s) 4-12 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a)  The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

The amendment filed January 10, 2002 amending claims 1, 12, 17 and 22 and adding claims 25-35 has been entered.

Claims 1-14 and 17-35 are pending.

Rejections and/or objections not reiterated from previous Office action are hereby withdrawn.

#### ***Claim Objections***

Claims 1 and 27 are objected to because of the following informalities: it appears that "the group consisting of" is missing at the end of line 1.

Claim 27 recites "7oxononanoate" where it appears "7-oxononanoate" should be typed.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 17-24 and 35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection has been explained in the Office action mailed July 6, 2001.

Claims 17-24 and 35 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a polynucleotide encoding an aminotransferase having an amino acid sequence as set forth in SEQ ID NOs: 25-32 and fragments thereof of 10-50 nucleotides, does not reasonably provide enablement for a probe of 10-50 nucleotides that are 70% complementary to a polynucleotide encoding SEQ ID NOs: 25-32. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

This rejection has been explained in the Office action mailed July 6, 2001.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 17-24, 31, 33 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is drawn to a probe of "about 10 to 50 nucleotides". It is confusing because according to the definition in the specification probes have "at least 10" nucleotides (page 11, last paragraph).

Claims 18-24 and 35 are rejected as dependent from claim 17.

Claim 31 is unclear as reciting "histidinol-phosphate aminotransferase" wherein the specification recites "histidinol-phosphate aminotransferase" on page 5, lines 2-3, and "histidine-phosphate aminotransferase" on page 26, last line.

Claim 33 is unclear as reciting "aminotransferases" activity. Any of SEQ ID NOs: 25-32 exhibit a specific aminotransferase activity.

#### ***Double Patenting***

Claims 1-3, 13, 14 and 25-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of Application No. 09/412,184 issued as US Patent 6,268,188 on July 31, 2001. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are claiming common subject matter, as follows: a polynucleotide having at least 70% identity to a nucleic acid encoding SEQ ID NOs:25-32.

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This double patenting rejection is reiterated from the Office actions mailed January 30, 2001 and July 6, 2001. Applicants' request for a delay in responding to this rejection is noted (Remarks, page 4, 2nd paragraph). The rejection is maintained until a TD is filed.

***Allowable Subject Matter***

Claims 4-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed January 10, 2002 have been fully considered but they are not persuasive.

With regard to probes of 10-50 nucleotides that are 70% complementary to a polynucleotide encoding SEQ ID NOs: 25-32, Applicants argue that "the Office Action again incorrectly focuses on the function of a polypeptide rather than the function of the claimed probe" (page 8, 1st paragraph). And further that the function is "to function as a probe" (*ibid*). This is not persuasive because every oligonucleotide can function as a probe, such definition does not distinguish the claimed probes from others in the same class. The specificity can distinguish it but it is not claimed. Regarding the

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enablement, if the probe is not specific, it will hybridize to many functionally and structurally different DNAs and, therefore, is of no use for recovery of a specific DNA of SEQ ID NOs: 25-32.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Slobodyansky whose telephone number is

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(703) 306-3222. The examiner can normally be reached Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX phone number for Technology Center 1600 is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Center receptionist whose telephone number is (703) 308-0196.

  
Elizabeth Slobodyansky, PhD  
Primary Examiner

March 19, 2002